

REMARKS/ARGUMENTS

In the Office Communication, the Examiner alleges that the Amendment filed on November 11, 2005 is not responsive to the Office Action mailed June 14, 2005. According to the Examiner, claim 42 is directed to an invention that is independent or distinct from the inventions claimed in the original or previously examined claims. The Examiner states that previously examined claim 30, which is drawn to a method for determining an IBD or pre-IBD phenotype of a test cell from a given tissue, is distinct from claim 42, which is drawn to a method for diagnosing IBD in a subject. As a result, the Examiner has withdrawn claims 42-52 from consideration for allegedly being drawn to a non-elected invention and constructively elected claims 30-41.

In order to expedite prosecution of the present case, Applicant has amended claim 42 to recite a method for determining an IBD or pre-IBD phenotype of a test cell from a given tissue. Support for the amendment is found, for example, on page 2, lines 15-28 and on page 42, lines 25-34 of the instant specification. Applicant has also amended claim 47 to establish proper antecedent basis from amended claim 42. Support for the amendment is found, for example, from page 41, line 30 to page 42, line 1 of the instant specification.

Based on the foregoing, Applicant asserts that amended claim 42 clearly belongs to the same class of invention as set forth in previously examined claim 30. In particular, both claims are drawn to a method for determining an IBD or pre-IBD phenotype of a test cell from a given tissue. Applicant further asserts that amended claim 42 belongs to the same group of invention as set forth in original claims 5-7. These claims were classified by the Examiner as being drawn to a method for determining the phenotype of a cell (Group IV; *see*, pages 2-3 of the Office Action mailed February 12, 2002) and subsequently elected by Applicant for prosecution (*see*, pages 5-6 of the Response to Restriction Requirement dated May 13, 2002). As such, Applicant believes that amended claim 42 and all claims dependent therefrom are drawn to the elected invention.

The Examiner also states that claim 42 requires a different mode of operation to practice the claimed method than the original or previously examined claims. According to the

Examiner, claim 42 does not comprise determining an expression level of a gene product by detecting hybridization as set forth in previously examined claim 30. In response, Applicant respectfully reminds the Examiner that the determination of an expression level of a gene product can be performed using hybridization techniques such as Northern blot analysis, reverse transcription-polymerase chain reaction, in situ hybridization, and an array (*see*, claim 48 and page 42, lines 2-9 of the instant specification). For example, array-based techniques comprise spotting nucleic acid probes onto a substrate in a two-dimensional matrix or array and detecting hybridization between the nucleic acid probes and gene products (*see*, page 45, lines 24-28 of the instant specification). Similarly, in situ hybridization comprises detecting hybridization between a nucleic acid probe and a gene product in a test cell (*see*, page 42, lines 17-24 of the instant specification). As such, contrary to the Examiner's allegation, amended claim 42 and all claims dependent therefrom do not require a different mode of operation to practice the claimed method.

In view of the foregoing remarks, Applicant believes the Amendment filed on November 11, 2005 is now responsive to the Office Action mailed June 14, 2005. Accordingly, Applicant respectfully requests that the Examiner enter both the previous and present Amendments and reinstate claims 42-52 for examination on the merits.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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